

## **REMARKS**

Claims 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 are pending in this application and subject to consideration. Claims 14-21, 35-42 and 55-58 have been previously withdrawn from consideration. Claims 1, 8, 11, 22, 29, 32, 43 and 51 have been amended. No new matter is added. Reconsideration of the application is respectfully requested.

### **I. Restriction Requirement**

In response to the Restriction Requirement dated June 30, 2006, The Applicants hereby provisionally elect claims **1-6, 8-13, 22-27, 29-34, 43-54, and 59-62** of **Group I** directed to text-to-speech functions.

Applicants reserve the right to file one or more divisional applications directed to the non-elected claims. This election is made **with traverse**, as the Applicants respectfully submit that examination of all claims presents no undue burden on the Examiner.

### **II. 35 U.S.C. §112 Rejections**

The Office Action mailed February 8, 2008, rejects claims 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 under 35 U.S.C. § 112, first paragraph, and under 35 U.S.C. § 112, second paragraph. To the extent the rejections remain applicable to the claims as amend, Applicants respectfully traverse the rejections as follows.

35 U.S.C. §112, first paragraph, recites "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same."

Further, in order to make a rejection for inadequate written description, “[t]he Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (M.P.E.P §2163.04).

The Office Action takes the position that “the specification fails to provide details to make and use the claimed invention without using a word processor.” The Applicants note the position the Office Action takes regarding the Applicants’ arguments. However, the Applicants submit that the test, as defined in the statute and the M.P.E.P., is whether a person skilled in the art would be able to make and use the invention, not whether the Specification provides details on how to implement the invention in a specific way. See 35 U.S.C. §112.

Additionally, the Office Action, on page 4, lines 18-20, takes the position that “the applicant’s argument that the claimed function cannot be performed by a word processor as taught by the prior art is false.” The determination of whether a claim can be rejected under 35 U.S.C. §112 is unrelated to whether the claimed function is performed by the prior art, and therefore, the Office Action’s assertion is irrelevant to the 35 U.S.C. §112 rejections. The test, as defined in the statute and the M.P.E.P., is whether a person skilled in the art would recognize in an applicant’s disclosure a description of the invention described in the claims not whether the prior art can perform the functionality of the claim. See M.P.E.P. §2163.04.

Regarding the hindsight argument made in the Response filed on September 14, 2007, the Applicants respectfully submit that M.P.E.P. §2145 XA states “[a]pplicants may argue that the examiner’s conclusion of obviousness is based on improper

hindsight reasoning” and “[a]pplicants may also argue that the combination of two or more references is “hindsight” because “express” motivation to combine the references is lacking. Therefore, Applicants respectfully submit that the hindsight argument was proper under M.P.E.P. §2145 XA.

Accordingly, Applicants respectfully submit the 35 U.S.C. §112, first and second paragraph, rejections are in error and the subject matter of the claims fulfill the requirements of 35 U.S.C. §112, first and second paragraph. Withdrawal of the rejection is respectfully requested.

## **II. 35 U.S.C. §103(a) Rejections**

The Office Action rejects claims 1-6, 8-13, 22-27, 29-34, 43-46, 49, 51-54 and 59-62 under 35 U.S.C. § 103(a) over Holm et al. (U.S. Patent No. 5,850,629) in view of Simpson (“Mastering WORDPERFECT® 5.1 & 5.2 for Windows”) and Dictionary (Microsoft Press Computer Dictionary, Second Edition, 1994); and claims 47-48 and 50 under 35 U.S.C. § 103(a) over Holm in view of Simpson and Dictionary as applied to claim 43, and further in view of Fawcett et al. (U.S. Patent No. 5,802,526). To the extent the rejects remain applicable to the claims as amended, Applicants respectfully traverse the rejections as follows.

The Applicants respectfully submit that the applied references, taken alone or in combination, fail to disclose or suggest a method for providing text-to-audio conversion of an electronic book displayed on a viewer that includes selecting an electronic book for viewing from a list of available electronic books stored in an operations center; displaying a page of the selected electronic books on the viewer, the page including text, wherein the operations center is remote from the viewer, as recited in amended

independent claim 1 and similarly recited in independent claims 8, 11, 22, 29, 32, 43 and 51.

Regarding the dependent claims, each of which depends from one of allowable claims 1, 8, 11, 22, 29, 32, 43 and 51, the Applicants respectfully submit that these claims are allowable over the cited references for at least the same reasons as outlined above, as well as for the additional subject matter recited therein.

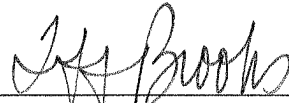
### **III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 026880-00014.**

Respectfully submitted,



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